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In the United States District Court
for the Northern District of California

ROGER SCHLAFLY, Plaintiff

v.

PUBLIC KEY PARTNERS, and
RSA DATA SECURITY INC., Defendants.

and

RSA DATA SECURITY INC., Plaintiff

v.

Cylink, Caro-Kann, and Stanford

) Case C-94-20512 SW PVT

) Memo on Claim Construction
) Jury Instructions

) Case C-96-~~20094~~ SW PVT

) Sept. 30, 1996

This memorandum is in support of my jury instructions regarding
claim construction, and critical of those offered by Cylink and
RSADSI.

1 Schlafly Instructions

2
3 The definition of "key generator" is important because it has a
4 direct bearing on whether RSA key transmittal reads on Diffie-
5 Hellman claim 1. From the specification and file history, it is
6 clear that the invention is a method for generating a new key, not
7 transmitting an existing key.

8
9 The term "computationally infeasible" is crucial for understanding
10 the scope and validity of Hellman-Merkle claims 1-6. The
11 specification defines it using the phrase "existing computational
12 methods and equipment". It is clear enough that "equipment" means
13 general-purpose digital computers of a speed and capacity that was
14 available in 1977. But it is a little ambiguous as to what is
15 meant by "methods". It could refer to the low-level computer
16 methods that were available in 1977, such as using computer
17 processors to add numbers by loading them into registers, using
18 memory devices to store intermediate results, using compilers and
19 operating systems to translate and execute a program, etc. Or it
20 could refer to high-level algorithms that might be used to attack
21 the cryptosystem. The former interpretation is consistent with
22 common usage of the term "infeasible" in computational complexity
23 theory, which the inventors specifically rely on in the patent and
24 in their cited papers. The latter interpretation would be rather
25 bizarre in terms of either patent law or usage in the art, because
26 it refers to the state of the world's knowledge. Researchers in
27 complexity theory try to prove theorems about what is or is not
28 possible to compute, not about what we know how to compute.

1 Likewise, a patent claim should serve as an objective notice to
2 the world about what is the boundary of the invention, and should
3 not depend on extrinsic knowledge or the lack thereof.

4
5 Here is an example of this type of claim construction confusion.
6 Suppose I invented an extraordinarily strong rope, and patented it
7 by claiming an "unbreakable rope". The examiner would be very
8 unlikely to allow such a claim because claiming a negative in this
9 way is almost always considered "indefinite", but suppose
10 for the sake of argument that I defined unbreakable in the
11 specification as meaning that no one knows how to break it, and
12 the patent office allows the patent. Then interpreting the scope
13 of the claim becomes rather silly. My rope might only satisfy the
14 claim because it was kept secret during patent prosecution, and no
15 one knew how to break it because no one knew about it. Likewise,
16 I might argue that a competitor's product infringes, whether it
17 can be broken or not, just because it is a new product and
18 therefore no one knew how to break it at the time of my patent
19 application. The courts would surely find such a claim
20 interpretation to be indefinite. (More reasonable claims for such
21 a rope would be in terms of the quantity of force required to
22 break it.)

23
24 When there are two possible claim interpretations, a valid one is
25 to be preferred over an invalid one. Therefore, I believe the
26 latter interpretation of "infeasible" (depending on world
27 knowledge, described above) should be rejected because it leads to
28 indefinite claims.

1 (I am hoping that the meaning of "infeasible" will become clearer
2 after the tutorial and expert testimony, so I will not elaborate
3 further here.)

4
5 Cylink Instructions

6
7 Cylink instruction no. 2 overstates the law. The obvious
8 exceptions to its general rule are the means-plus-function claims,
9 step-plus-function claims, and the reverse doctrine of
10 equivalents. Since only one of these exceptions is detailed in
11 Cylink's instructions, I believe that no. 2 is misleading. The
12 statement in instruction no. 1 makes the point adequately.

13
14 The definitions in instruction no. 3 are all reasonably consistent
15 with the specification. My inclination is to let Cylink define
16 these terms, because I believe that the Hellman-Merkle claims are
17 invalid anyway, no matter how the claims are interpreted. If the
18 claims are interpreted broadly, then the "Multiuser" paper is
19 invalidating prior art under 35 USC 102(b). If "infeasible" is
20 defined narrowly, then the patent is not enabled and invalid under
21 35 USC 112-1. If we use a contorted definition which includes the
22 trapdoor knapsack and not "Multiuser", then the claims are
23 indefinite under 35 USC 112-2.

24
25 I am not waiving my invalidity attacks by conceding these
26 definitions, but rather seeking to avoid retrying patent validity
27 under different definitions. For example, the Federal Circuit
28 might say on appeal that the patents were correctly found to be

1 invalid under the Judge's claim construction, but remand the case
2 anyway for validity analysis under some other claim construction.
3 The chances of this are minimized if this Court uses a claim
4 construction close to what Cylink requests.

5
6 The main ambiguities in Cylink's definitions are in connection
7 with "key generator" and "computationally infeasible", as argued
8 above. I would like to come out of the Markman hearing with a
9 more precise meaning for these two terms.

10
11 My only minor quibble with Cylink's definitions is the distinction
12 between technology and "ordinary life". For some of us, there is
13 not much of a distinction. (This is a joke!)

14
15 Cylink's instructions 4 and 5 contain fairly accurate statements
16 of the means-plus-function law under 35 USC 112. My main
17 disagreement with Cylink is that RSADSI and I contend that the
18 method claims at issue are step-plus-function claims, and subject
19 to the same 35 USC 112 limitations.

20
21 RSADSI Instructions

22
23 RSADSI's jury instructions seem rather long and complicated, but
24 most of its document consists of a recitation of the support in
25 the patent specifications for the claimed elements of the
26 inventions. Based on a Sept. 16 meeting of the parties, I expect
27 that we will be able to stipulate nearly all of this in a separate
28 document.

1 The biggest difference between the Cylink and RSADSI instructions
2 is in the interpretation of 35 USC 112-6,

3
4 An element in a claim for a combination may be expressed as
5 a means or step for performing a specified function without
6 the recital of structure, material, or acts in support
7 thereof, and such claim shall be construed to cover the
8 corresponding structure, material, or acts described in the
9 specification and equivalents thereof.

10
11 RSADSI argues that all of the claims are subject to the
12 limitations of 112-6, and that the jury should have its attention
13 drawn to specific embodiments so that it will interpret the range
14 of equivalents narrowly.

15
16 Cylink argues that the method claims at issue are not subject to
17 112-6 limitations. It prefers to give a blanket instruction on
18 how 112-6 applies to apparatus claims.

19
20 RSADSI's claim construction is a little narrower than I would
21 argue, but since RSADSI is on my side, I will let RSADSI argue
22 it with Cylink.

23
24 Possible Compromise

25
26 The obvious compromise is to let Cylink define the terms, with
27 ambiguities clarified as necessary; stipulate the structures and
28 acts in the specifications supporting the claims; and use textbook

1 language to explain the legal effect of claims, 112-6,
2 equivalence, etc.

3
4 The one legal issue where we cannot compromise is whether the
5 method claims (eg, Hellman-Merkle claim 1) are subject to the
6 limitations of 35 USC 112-6. My position is that Diffie-Hellman
7 claims 1-7 and Hellman-Merkle claims 1-6 are all subject to 35 USC
8 112-6 limitations. We will need the Court to rule on this point.

9
10 I will be urging the Court to construe the claims as precisely as
11 possible. It will simplify the later arguments on validity and
12 infringement.

13
14
15 Dated: Sept. 24, 1996

16
17 By:  _____

18
19 Plaintiff, Roger Schlafly, Pro Se
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CERTIFICATE OF SERVICE

=====

Schlafly v. Public Key Partners and RSA Data Security Inc.
Case No. C-94-20512-SW, (PVT).

Filed on July 27, 1994, San Jose, Calif.

The undersigned hereby certifies that he caused a copy of:

Memo on Claim Construction Jury Instructions

to be served this date by First Class Mail upon the
persons at the place and address stated below which is
the last known address:

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I declare under penalty of perjury under the laws of the State
of California that the foregoing is true and correct.

Executed in Soquel, Calif. at the date below.

Dated: Sept. 24, 1996

By:  _____

Plaintiff, Roger Schlafly, Pro Se